IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants:	Jay S. Walker, Jose A. Suarez, T. Scott Case, Michiko Kobayashi, Andrew P. Golden
Application No.:	09/605,818
Filed:	June 28, 2000
Title:	SYSTEM FOR UTILIZING REDEMPTION INFORMATION
Attorney Docket No.:	00-001
Group Art Unit:	3625
Examiner:	Mark A. Fadok

SUPPLEMENTAL REPLY BRIEF

BOARD OF PATENT APPEALS
AND INTERFERENCES

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Appellants hereby submit remarks in this Supplemental Reply Brief pursuant to 37 C.F.R. §§ 41.41, 41.43(b) and in response to the Supplemental Examiner's Answer mailed on November 28, 2006 (hereinafter the "Supplemental Examiner's Answer"). This Supplemental Reply Brief is submitted as a supplement to (i) the Appeal Brief mailed on March 6, 2006, and (ii) the Reply Brief mailed on August 15, 2006, and should, if applicable, be considered as a request to maintain the current appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed September 13, 2005 (Part of Paper No./Mail Date 20050908), rejecting claims **1-11**, **38-42**, and **51-55**.

REMARKS

I. Improper Supplemental Examiner's Answer

The Examiner claims that the Supplemental Examiner's Answer is "compelled" due "to the entry of a substantial number of **new arguments**" presented in Appellants' Reply Brief. Supplemental Examiner's Answer, pg. 2, second paragraph; emphasis added.

Appellants respectfully point out that "**new arguments**" in a Reply Brief are insufficient to warrant the filing of a Supplemental Examiner's Answer. Specifically, a Supplemental Examiner's Answer is only allowed in response to a Reply Brief if "**new issues**" are raised in the Reply Brief. 37 C.F.R. § 41.43(a)(1); MPEP §1207.05.

> The following are examples of new issues raised in a reply brief that would give the examiner the discretion to provide a supplemental examiner's answer:
>
> Example 1: The rejection is under 35 U.S.C. 103 over A in view of B. The brief argues that element 4 of reference B cannot be combined with reference A as it would destroy the function performed by reference A. The reply brief argues that B is nonanalogous art and therefore the two references cannot be combined.
>
> Example 2: Same rejection as in example 1. The brief argues only that the pump means of claim 1 is not taught in the applied prior art. The reply brief argues that the particular retaining means of claim 1 is not taught in the applied prior art.
>
> MPEP §1207.05(I)

In the present case, Appellants' Reply Brief did not raise any "**new issues**". Appellants' Reply Brief did not, for example, present any arguments directed to any claim limitations not previously argued nor present any arguments directed to any elements of a claim limitation not previously argued. Instead, the Reply Brief was directed to answering various allegations made by the Examiner in the Examiner's Answer and to reiterating arguments presented in the Appeal Brief.

Accordingly, as Appellants' Reply Brief is believed to only address **old issues**, the Supplemental Examiner's Answer submitted by the Examiner is believed to be improper. While Appellants request herein that the Board act to remedy this error, Appellants also hereby notify the Board that a separate Petition to the Director under 37 C.F.R. §§ 1.181, 1.182 is being concurrently filed herewith in an attempt to properly exhaust all options for remedy.

II. No New Grounds for Rejection

Appellants note that the Examiner has, in the Supplemental Examiner's Answer, verified that no new grounds of rejection with respect to the claims being appealed were presented in the Examiner's Answer mailed on June 15, 2006. Accordingly, and as 37 C.F.R. §41.43(a)(2) prohibits new grounds of rejection from being set forth in the Supplemental Examiner's Answer, this Supplemental Reply Brief is submitted voluntarily pursuant to 37 C.F.R. § 41.41.

III. No *Prima Facie* Case for Obviousness

Despite the Examiner's clarification of certain arguments, which is greatly appreciated, the Examiner has failed to correct deficiencies that have prevented the proper formulation of a *prima facie* case for obviousness.

A. The References Fail to Teach or Suggest: *receiving, via an electronic communication network, information relating to* ***a redemption****, of the* ***product*** *and by the customer, that has occurred*

The Examiner states that Lough teaches "inputting sales data resultant of a redemption of a contact [sic] for sale into an electronic database (MLS)". Final Office Action, pg. 5, lines 11-14. Even if the Examiner's characterization of

Lough were correct (which Appellants maintain it is not, as described herein), it is not clear (1) how the Examiner believes that a real estate contract can be considered to be "redeemed" (See, Examiner's Answer, pg. 6, line 10 – "the redemption being in the form of a signed contract presented at closing"; See also, Appellants' arguments at Appeal Brief, pg. 22, last two lines to pg. 23, line 13 and Reply Brief, pg. 5, six lines from the bottom to pg. 6, line 5), nor (2) how real estate can readily be considered a "product" (See, Appellants' Appeal Brief, pg. 23, fourth line from the bottom to pg. 24, line 8).

***1. Redemption** information*

Even if Lough taught or suggested a "receiving", as claimed (which Appellants maintain it does not), Lough fails to teach or suggest "**redemption** information", much less the receiving thereof.

The Examiner appears to strongly believe that Lough teaches entering information about real estate sales into the Multiple Listing Service (MLS), which the Examiner appears to believe is equivalent to the claimed "**redemption** information". Appellants thank the Examiner for clarifying (despite the Examiner's previous remarks to the contrary[1]) that the Lough reference, and in particular the term "comparable sales", as used in Lough, is not being interpreted by the Examiner via support from either the use of Official Notice nor the support of any Personal Knowledge. Instead, the Examiner is relying solely upon newly submitted evidence – a definition from a dictionary of Real Estate terms – to determine the meaning of the term "comparable sales" as used in the Lough reference, upon which the Examiner relies to show how Lough allegedly teaches the entering of real estate sales data.

[1] See, Examiner's Answer, pg. 6, first paragraph.

a) Misinterpretation of Lough - Generally

Initially, Appellants must reiterate that the Examiner is simply misinterpreting the Lough reference. See, Appeal Brief, pg. 23, lines 7-22, and Reply Brief, pg. 5, lines 1-6. Lough specifically states that the "comparable sales" information is "available virtually the moment a property is listed". Lough, pg. 2, sixth paragraph. There appears to be no feasible way that Lough could be referring to 'real estate sales' data (*i.e.*, data regarding what prices real estate has sold for) as being available as soon as a property is listed. In other words, **how can the price a property *sold for* be known before the property has been sold?**

b) Misinterpretation of the Term "Comparable Sales"

Appellants further note that the Examiner now relies upon a dictionary definition of the term "comparables" to support the Examiner's interpretation of the term "comparable sales" in Lough. Supplemental Examiner's Answer, pg. 3. Appellants respectfully point out that the real estate term "comparables" relied upon by the Examiner does not appear in Lough. Instead, Lough describes "comparable sales". While similar, the two terms are definitely different, and one would assume that if "comparables" were meant to be described by Lough, then Lough would have been written to include the term "comparables", instead of the term "comparable sales", which was ultimately selected and published. Based on the fact that Lough is directed to describing properties that are *for sale* (*i.e.*, properties offered for sale), it seems quite likely that the term "comparable sales" in Lough was chosen to represent other similar properties offered for sale – as opposed to properties that have already been sold.

Appellants further note that even if the use of the term "comparable sales" in Lough were somehow considered equivalent to the term "comparables" as suggested by the Examiner, the definition of "comparables" supplied by the Examiner does not define "comparables" as *properties that have sold*. Instead, the definition states "comparables" means "properties that are similar to the one being sold". Barron's Dictionary of Real Estate Terms, Second Edition (1987), pg. 57, definition of "comparables". While the example following the definition makes clear that the definition *may* include properties that have sold, nothing in the definition *requires* properties to have been sold to qualify as "comparables". Accordingly, while "comparables" may include properties that have sold, it may also include properties that have not sold, which is the population of properties that Appellants believe is contemplated in Lough.

c) The Claim Term "Redemption"

Appellants thank the Examiner for pointing out that the term "redemption", as described in Appellants' specification as filed, is not specifically limited to situations in which a product is purchased and then later retrieved. Instead, Appellants' specification describes situations in which products are purchased and then later retrieved, as well as situations in which a customer commits/agrees to purchase a product that is then picked up, which contemplates the case where the product is pre-paid, as well as the case where the product is paid for at the time of redemption or even later.

Appellants note, however, that the Examiner states there is no support in Appellants' specification for the interpretation of the term "redemption" that includes pre-purchase and subsequent retrieval of a product. Supplemental Examiner's Answer, pg. 4, line 4 to end. Specifically, the Examiner quotes a

portion of Appellants' specification and characterizes that portion by stating that the "excerpt clearly associates redemption with a payment after the [sic] product the is redeemed." Supplemental Examiner's Answer, pg. first paragraph from the bottom.

Appellants respectfully note that the portion of Appellants' specification cited by the Examiner simply described various forms of redemption information that may be transmitted (and accordingly received) by the central controller. Appellants note that the redemption information is described as potentially comprising a "retail price" of the product being redeemed. This does not necessarily mean that the customer pays the retail price at the time of redemption. Instead, as a reading of Appellants' specification should make clear, this "retail price" information can then be utilized by the central controller to determine whether to accept a subsequent offer for the product. Nor does a "total amount of money charged to the customer by the retailer" necessarily describe the customer paying for the product at the time of redemption (although this is clearly contemplated as well). Instead, it generally describes a situation in which the customer may, in addition to consummating the redemption, make one or more purchases at the retailer. This information may be useful, for example, to determine how much revenue volume is being driven to the retailer by the redemption system.

Appellants further respectfully note that, contrary to the Examiner's assertion, Appellants' specification as filed does describe a "redemption" process as comprising an initial purchase of a product followed by a retrieval of the purchased product. Appellants' specification states, for example:

> According to this embodiment, a customer accesses a website maintained by a controller and transmits to the website an offer to purchase a product for an offer price. If the offer is acceptable, the controller informs a retailer to provide the product to the customer. The

> controller also informs the customer that the offer has been accepted, transmits a redemption identifier to the customer, and informs the customer that the redemption identifier must be presented to the retailer in order to redeem the product from the retailer.
>
> Specification, pg. 6, lines 9-16.

In other words, since the purchase offer has been accepted, the customer only needs to provide a redemption identifier to the retailer to pick up the product – *i.e.*, since the product was already purchased.

Further, Appellants' specification states that the Parent and Related applications that are referenced and/or incorporated by reference "describe various systems for **remotely purchasing a product** and for **subsequently retrieving the product** at a local retailer. For example, a customer may access an "online" retailer using his home computer, **purchase a product** from the retailer and **pick up the product** at a nearby 'brick and mortar' retailer." Specification, pg. 2, lines 7-11; emphasis added. Appellants' specification further intimates that the present disclosure is generally directed to utilizing information *associated with such redemptions* to provide beneficial and advantageous results. See, Specification, pg. 2, lines 24-27.

At least in light of these reasons, Appellants believe that Lough fails to teach or suggest the claimed limitation. Appellants further believe that the Examiner has failed to set forth a *prima facie* case of obviousness by failing to show how the claimed limitation is taught or suggested by the cited reference. Accordingly, Appellants request that the outstanding § 103(a) rejections be reversed.

2. Product

Appellants reiterate that "real estate" is not equivalent to a "product". See, Appellants' Appeal Brief, pg. 23, fourth line from the bottom to pg. 24, line 8. Considering real estate as a "product" becomes specifically untenable when applied to claim limitations such as recited in dependent claim **7**, where an "amount of product" is utilized. The Examiner brushes aside this limitation by simply noting that in Lough, the quantity of product is "(1 house)". Final Office Action, pg. 6, second paragraph.

A "product", is defined by Appellants' specification as filed as: (i) "Agreement Product: A product of which a customer agrees to purchase and an entity **agrees to supply a number of units**" (Specification, pg. 5, lines 21-22; emphasis added), and (ii) "Offer Product: A product of which a customer offers to purchase, or an entity offers to provide, **a number of units**. After the offer is accepted, the offer product is referred to as an agreement product" (Specification, pg. 5, lines 30-32; emphasis added). It is unclear how the Examiner believes that real estate can reasonably fall within the scope of these definitions, where it is clearly contemplated that *multiple units of a single product* can be purchased and redeemed.

Appellants believe that Lough fails to teach or suggest the claimed limitation. Appellants further believe that the Examiner has failed to set forth a *prima facie* case of obviousness by failing to show how the claimed limitation is taught or suggested by the cited reference. At least for these reasons, Appellants request that the outstanding § 103(a) rejections be reversed.

B. Still No Motivation to Combine

The Examiner has *not yet provided any evidence* as to why it is believed that it would have been obvious to combine the cited references in the manner suggested by the Examiner. Appellants respectfully note that **mere statements by the Examiner** of what he believes would have been obvious **do not constitute evidence**.

Further, it remains unclear how the alleged motivation, presented as a desire to "increase revenue by supplying accurate and timely information to the client" (Final Office Action, pg. 5, lines 14-16), is applicable to utilizing redemption information for a product (such as retail price information) to determine whether to accept a subsequent offer for the product. See, for example, Claim **1**; Specification, pg. 22, lines 17-20. In other words, how could the desire to supply "accurate and timely information to [a] client" motivate a combination of references to allegedly create claim **1**, where claim **1** is directed to utilizing information to determine which offers for product purchases to accept, not to supplying information to customers/clients?

Appellants believe that the Examiner has failed to set forth a *prima facie* case of obviousness by (i) failing to describe why one of ordinary skill would have been motivated to combine the references to produce the claimed embodiments, and (ii) by failing to provide any evidence in support of any allegation of motivation. At least for these reasons, Appellants request that the outstanding § 103(a) rejections be reversed.

C. Non-Analogous References

As described in Appellants' Appeal Brief (See, Appeal Brief, pg. 27, Section 4.4.1.3.), at least by failing to make any showing regarding the level of ordinary skill in the art, the Examiner is necessarily unable to determine which references are analogous to the pending claims. Appellants further submit that neither of the cited references is analogous to the pending claims. The pending claims are directed to the sale and redemption of products, particularly via product redemption at retailers, while each of the cited references is clearly an article describing standard real estate sales. The two fields are quite disparate. Nor is either of the cited references directed to solving the same problem(s) as those solved by the pending claims. While the pending claims are generally directed to utilizing redemption information for a product to determine whether to accept subsequent offers to purchase units of the product, for example, each of the cited references appears to be directed to solving no particular problem, much less any problems associated with product sales and/or redemptions.

Accordingly, as neither of the cited reference is believed to be analogous to the pending claims, Appellants respectfully request that the outstanding § 103(a) rejections be reversed.

IV. Conclusion

At least for the above-stated reasons, in supplement to those submitted and described in any or all of the Appellants' Request for Pre-Appeal Brief Review (mailed on December 12, 2005), the Appeal Brief, and the Reply Brief, Appellants respectfully request that the Examiner's rejections of the pending claims be reversed.

Respectfully submitted,

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Date

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